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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,124	11/17/2006	Tomohiko Ohta	L7350.0010	1070

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EXAMINER

GUSSOW, ANNE

ART UNIT	PAPER NUMBER
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1643

MAIL DATE	DELIVERY MODE
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03/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/588,124	Applicant(s) OHTA, TOMOHIKO	
	Examiner ANNE M. GUSSOW	Art Unit 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/1/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of Group V, claim 10, in the reply filed on December 31, 2007 is acknowledged.
2. Claims 1-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 31, 2007.
3. Claim 10 is under examination.

Priority

4. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d), a certified English translation of the foreign application, PCT/JP05/01870 must be submitted in reply to this action. 37 CFR 41.154(b) and 41.202(e).

Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

The claims receive the priority date of November 17, 2006 for art rejections in this office action.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on August 1, 2006 has been considered by the examiner and an initialed copy of the IDS is included with the mailing of this Office Action.
6. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

7. Color photographs and color drawings are not accepted unless a petition filed under 37 CFR 1.84(a)(2) is granted. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and, unless already present, an amendment to include the following language as the first paragraph of the brief description of the drawings section of the specification:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings and black and white photographs have been satisfied. See 37 CFR 1.84(b)(2).

The petition to enter color drawings has been received however, there are no accompanying copies of a color drawing or figure in the case.

Specification

8. The disclosure is objected to because of the following informalities: in the description of the figures, a separate description is necessary for each part (i.e. A-D) of each figure for the following figure numbers: 1, 2, 3, and 6.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Wang, et al. (Oncogene, 1997. Vol. 15, pages 143-157, as cited on the IDS).

The claim recites a method of transporting BRCA1 from a nucleus to cytoplasm comprising co-expressing BRCA1 and CDK2-cyclin E and/or CDK2-cylin A.

Wang, et al. teach analysis of protein transport in cells in the absence of serum. Wang, et al. teach BRCA1 is associated with cyclins/CDKs including CDK2 and cyclin A. Since the only active step of the claim is the co-expression of BRCA1 and CDK2-

cyclin A, and Wang, et al. teach that BRCA1 and CDK2-cyclin A interact with one another in cells, all the limitations of the claims have been met.

11. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Rao, et al. (US PAT 6,720,158, issued April 13, 2004).

The claim has been described supra.

Rao, et al. teach that BRCA1 associates with cyclins and cdks, specifically, cdk2 and cyclin A in GST pull down assays and immunoprecipitation (column 7). Since the only active step of the claim is the co-expression of BRCA1 and CDK2-cyclin A, and Rao, et al. teach that BRCA1 and CDK2-cyclin A associate with one another in cells, all the limitations of the claims have been met.

12. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Hayami, et al. (Cancer Research, 2005. Vol. 65, pages 6-10, as cited on the IDS).

The claim has been described supra.

Hayami, et al. teach transient transfection of BRCA1 into 293T cells with or without CDK2 and cyclin E1. Hayami, et al. teach that in the absence of cdk2 and cyclin E1 the BRCA1 protein level in the cytoplasm was lower than that in the nucleus while upon coexpression of cdk2 and cyclin E1 the level of cytoplasmic BRCA1 protein was increased relative to the level in the nucleus (page 8). Since the only active step of the method is coexpression of BRCA1 and cdk2-cyclin E and Hayami, et al. teach

coexpression of BRCA1 and cdk2-cyclin E, all the limitations of the claims have been met.

Conclusion

13. No claims are allowed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNE M. GUSSOW whose telephone number is (571)272-6047. The examiner can normally be reached on Monday - Friday 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Anne M. Gussow

March 7, 2008

/Larry R. Helms/
Supervisory Patent Examiner, Art Unit 1643